

REMARKS

By the above response, independent claims 5, 6 and 16, which previously recited similar features of which claim 6 is given as an example of the relation of "displaying the inputted defect candidate data on a screen in map format; and displaying on the screen an image of the defect candidate designated on the map displayed on the screen." (emphasis added) has been amended to further recite simultaneously displaying on the screen an image of the defect candidate designated on the map displayed on the screen, for clarification purposes and applicants submit that the amendment of claims 5, 6 and 16 to recite the "simultaneous display" feature is merely of a clarifying nature and does not raise new issues requiring further search and/or consideration. That is, in accordance with the present invention as illustrated in Fig. 8 of the drawings of this application, the screen includes a map display portion 55 and an image display portion 56. As illustrated in Fig. 8, in the map display portion 55, various defect candidate data is generally displayed on the map display portion 55 as indicated by the rectangles and circles. In accordance with the present invention, as described in the Substitute Specification, in the paragraph bridging pages 13 and 14, "the image of a defect specified from among the defects displayed on the map display portion 55 is displayed on image display portion 56, which corresponds to image displaying means 209 of Fig. 4". Although Figs. 4 and 8 do not illustrate the image displayed, as described in the paragraph bridging pages 13 and 14 of the Substitute Specification, a current location symbol 59 is displayed on the screen using the mouse operation command button 140 to select a selection mode 145 from among a selection mode 145 and a zooming mode 146, the current location display 59 is moved with the mouse and the image of a defect that a user wishes to see is displayed on image display portion 56 by clicking on the location of the defect to be viewed.

Applicants submit that, it is apparent that as previously recited in each of independent claims 5, 6 and 16, an image of the defect which is represented by the current location symbol 59 of the a defect candidate data which is displayed in the image display portion 55 of the screen is displayed on the image display portion 56 of the screen, even though Fig. 8 does not illustrate a displayed image in the image display portion 56. Thus, the simultaneous display, as now set forth in the claims, is inherent in the previous recitation and serves only for clarifying purposes and does not raise new issues requiring further search and/or consideration.

Further, by the present amendment, minor informalities in the independent and dependent claims have been corrected.

Applicants note that applicants consider an interview may be helpful in resolving any outstanding issues in this application, and the Examiner is requested to contact the undersigned attorney upon taking up this application for action to schedule such interview, if deemed necessary.

Turning to the rejection of claims 1-6 and 12-14 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,047,083, issued to Mizuno, and the rejection claims 6, 13, 15-16 and 20-24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,539,106, issued to Gallarda et al, such rejections are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To

establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Turning first to the rejection based upon Mizuno, applicants submit that the Examiner has apparently misunderstood the applicant's previous arguments concerning Mizuno. More particularly, under the heading "Response to Arguments" in paragraphs 39-41 at pages 8 and 9 of the Office Action, the Examiner recognizes that "Applicant alleges that the portions of Mizuno referred to by the Examiner fail to disclose the aforementioned features of a step of displaying an image of a defect candidate designated in the map displayed on the screen in the sense of 35 U.S.C. 102." (emphasis added). The Examiner contends that applicant's arguments do not clearly point out the patentable novelty and they do not show how the amendments avoid such references or objections. More particularly, the Examiner states "Here, Mizuno anticipates the claimed invention in that Mizuno discloses a map format for describing the locations of points of interest (i.e. defect locations) (col. 4, lines 35-40). If applicant contends that Mizuno's map format is not identical to the present limitation, he must clearly suggest the distinguishable feature." (emphasis added) Applicants do not contend that Mizuno does not disclose a map format for describing the location of points of interest, but rather, applicants submit that Mizuno does not additionally disclose, as recited in claim 6, for example, "displaying on the screen an image of the defect candidate designated on the map displayed on the screen".

Turning to Mizuno, irrespective of the position set forth by the Examiner in paragraphs 9, 10 and 13 at pages 3 and 4 of the Office Action, Mizuno does not disclose displaying the image of the defect candidate on the screen in addition to

display of defect candidate data in map format on the screen. That is, whether or not a defect is detected by comparing SEM images to obtain a different portion indicative of a defect as described in col. 5, lines 27-30 of Mizuno, and thereafter, a distance between a defect and the edge of the pattern is determined, with a defect then being classified in the manner described in Mizuno, applicants submit that Mizuno does not disclose in the sense of 35 U.S.C. 102 that the image of the defect is displayed on the screen on which is also displayed defect candidate data in a map format. That is, while Figs. 6A and 6B of Mizuno illustrate that defect candidate data is displayed on a screen in the map format, with Fig. 6B further indicating a classification of the defect candidates on the screen in the map format, applicants submit that Mizuno provides no disclosure in the sense of 35 U.S.C. 102 or teaching in the sense of 35 U.S.C. 103 of additionally displaying on the screen an image of the defect candidate which is designated on the map which is displays defect candidate data on the screen, as recited in the independent claims 5, 6 and 16 of this application, which feature has been clarified by the recitation of "simultaneously displaying" or the like. Thus, irrespective of the Examiner's position, applicants submit that each of independent claims 5, 6 and 16 patentably distinguishes over Mizuno in the sense of 35 U.S.C. 102 and should be considered allowable thereover.

Applicants submit that Figs. 2A-2D of Mizuno may be considered to represent images of a defect, the location of which is shown in map format in Figs. 6A and 6B with Fig. 6B further providing a display of the classification of the defect at such location in the manner illustrated in Fig. 6B. However, Fig. 6B of Mizuno fails to provide a display on the screen of the image of the defect in the manner corresponding to Figs. 2A-2D in addition to the location data in map format of the defect for a designated defect candidate, as recited in each of the independent claims of this application. Whether or not Mizuno would have the capability to provide such display is not the issue to be considered under 35 U.S.C. 102, but only

whether Mizuno provides a disclosure of the claimed features. Applicants further submit that it cannot be considered obvious in light of the teachings of Mizuno, particularly Fig. 6B, to provide the claimed features with the attendant advantages as described in the specification of this application. Thus, applicants submit that all claims patentably distinguish over Mizuno in the sense of 35 U.S.C. 102 and should be considered allowable thereover.

With respect to Gallarda et al, applicants submit that this patent also does not disclose displaying defect candidate data on a screen in map format and additionally displaying on the screen and additionally displaying on the screen an image of the defect candidate which is designated on the map of the defect candidate data displayed on the screen, as recited in the independent claims of this application. That is, while col. 6, lines 32-35 of Gallarda et al, indicate that at step 345, intermediate images and results, such as a map of defects and statistics about defect location, size, type, etc. are optionally displayed for monitoring by a human operator on a display screen 350 referring to Fig. 3 of Gallarda et al, applicants submit that the recited features of displaying defect candidate data in a map format on a screen and displaying on the screen an image of the defect candidate designated on the map displayed on the screen as previously recited in claim 6 as well as independent claims 5 and 16, and as now set forth "simultaneously displaying" is not disclosed by Gallarda et al in the sense of 35 U.S.C. 102. As such, applicants submit that the independent and dependent claims of this application also patentably distinguish over Gallarda et al in the sense of 35 U.S.C. 102 and should be considered allowable thereover. Applicants submit that it cannot be obvious in the sense of 35 U.S.C. 103 to provide the claimed features based upon the teachings of Gallarda et al, whether or not Gallarda et al would be capable of providing the claimed features.

For the foregoing reasons, applicants submit that the amendment, as presented, does not raise new issues requiring further search and/or consideration, and such amendment should be entered for clarifying purposes, it being recognized that the cited art fails to disclose the claimed features as originally presented and as amended by the present amendment. Accordingly, favorable action in this application is requested, it being noted that the Examiner is again requested to contact the undersigned to schedule an interview to resolve any outstanding issues, if deemed necessary.

Applicants further request that this paper be considered as a Notice of Appeal, and applicants appeal the final rejection of claims 2, 3, 5, 6, 10-16 and 20-24 as set forth in the Office Action dated January 2, 2004. Authorization is given for charging of the Notice of Appeal fee to the deposit account of the office of the undersigned attorney as set forth below, but request that any charge of Notice of Appeal fee be held in abeyance pending action by the Examiner on the amendments submitted herewith. That is, should the Examiner allow the application, a Notice of Appeal becomes unnecessary.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.41125X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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